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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/086,697

03/04/2002

Akitaka Shinohara

1086.1156

2796

21171 7590 06/12/2007  
STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

APPLE, KIRSTEN SACHWITZ

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

06/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/086,697

Applicant(s)

SHINOHARA ET AL.

Examiner

Kirsten S. Apple

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 14 March 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## Detailed Action

This action is in response to the application response filed on 3/14/07.

### *Restriction*

Newly submitted claim 8-36 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 10-19 & 31-36 are computer systems & computer program, claims 8-9 & 28-30 while methods claims include a selection criteria.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8-35 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### *Claim Rejections - 35 USC § 112*

In view of the applicants amendments the 112 rejections is hereby withdrawn.

### *Claim Rejections - 35 USC § 102*

The Examiner has read and reviewed all of the information provided by the Applicant. The examiner rejects as final claims 1-12 under 35 USC 102.

The Applicant attention is re-drawn to the following:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Carothers (US Patent Publication US 2002/0069117 A1).

**Re claim 1, 9-12:** Carothers discloses:

*A method, system, program, server, apparatus comprising:*

*Step receiving a request (by corporation or individual who is contract member requests a commerce transaction of a commodity purchase by participating in a marketplace) (see Carothers abstract, while this is shown in prior art it also is obvious physical auctions have existed for years and electronic action from well before the date of application including this step of receiving a request)*

*A mediation step of approving a purchaser to transact and attaching credit guarantee on the second marketplace based of the first contract. (see Carothers, "peer-to-peer" feature Figure 1, item 11 is mediation step between users 22 and member 32 & 34)*

**Re claim 2:** Carothers discloses:

*Mediation step = credit enquiry based on purchase history from first marketplace, when approved purchased is approved on second marketplace based on credit guarantee information. (see paragraph 60, line 10)*

**Re claim 3:** Carothers discloses:

*Mediation step = estimation based on plurality of items including: sending back (see paragraph 106)*

**Re claim 4:** Carothers discloses:

*Mediation step establishes an estimation standard, adds plus when item is satisfied and minus when item is not satisfied, determines guarantee based on total points (see paragraph 60, line 10 it is inherent in checking the credit that a method of ranking is used)*

**Re claim 5:** Carothers discloses:

*Mediation step show transaction information including the cost estimation and reply (see paragraph 60, line 1)*

**Re claim 6 & 7:** Carothers discloses:

*When commerce transaction is complete mediation step completes transaction by demanding payment from the purchaser from first marketplace and settling transaction on second marketplace (see paragraph 60, line 11)*

**Re claim 8:** Carothers discloses:

*When purchaser commits an unlawful transaction on the first marketplace mediation step discloses to second marketplace. (see Carothers, Figure 1, item 11 it is inherent in tracking the users that unlawful behavior would be known and shared)*

### ***Response to Arguments***

Applicant's arguments filed 3/14/07 have been fully considered but they are not persuasive.

In particular, and respect to Claim 1 the Applicant argued 1st: Carothers does not teach or suggest requesting to purchase the commodity from a second marketplace having a mediation contract with the first marketplace.

The Examiner refutes the argument made by the Applicant and draws the attention to Carothers, Figure 2, this depicts the peer-to-peer marketplace with includes by definition not just

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two (or a second marketplace) but an infinite number of marketplaces. For example MS2 (item 40 in this picture connects to 5 other MS (items 41-44 + 39) or 5 other marketplaces through a MA1 (or administer) this including having a mediation contract. MS2 (item 40) is also connect to another administer MA2 (item 52) While not depicted this item 52 is described to have multiple nodes and this structure can go on for infinitely.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Contact Information***

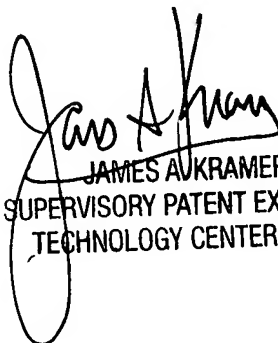
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 9:00-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa

  
JAMES A. KRAMER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600  
6/6/07